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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,291	01/30/2002	James L. Hartley	IVGN 127.8 CON	3302
65482 7590 11/26/2008 INVITROGEN CORPORATION C/O INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402				
EXAMINER				
GUZO, DAVID				
ART UNIT		PAPER NUMBER		
1636				
MAIL DATE		DELIVERY MODE		
11/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/058,291

Applicant(s)

HARTLEY ET AL.

Examiner

David Guzo

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 113-149 is/are pending in the application.
- 4a) Of the above claim(s) 125-149 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 113-124 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action
Election/Restriction

Applicant's election without traverse of Group I, Claims 113-124 in the reply filed on 8/14/08 is acknowledged.

Claims 125-149 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/14/08.

35 USC 112, 1st Paragraph Rejections

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 113-124 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants claim a nucleic acid molecule comprising, in order:

- (a) an origin of replication,
- (b) a first positive selection marker,
- (c) a first promoter,
- (d) a first site-specific recombination site,

(e) a coding sequence,
(f) a second positive selection marker,
(g) a second site specific recombination site, and
(h) a second promoter; wherein the first promoter is operably linked to the coding sequence, wherein the second promoter is operably linked to the second positive selection marker.

The first and second site-specific recombination sites are selected from *lox*, *loxP*, lambdoid *att* sites and mutants. The nucleic acid molecule (which can be an expression vector) can comprise at least one multiple cloning site and wherein the first and second positive selection markers can be the same or different antibiotic resistance genes.

Applicants assert that support for the claimed invention can be found in Figs. 4A, 4E, 8B and 8I as well as on p. 27, lines 3-12; p. 28, lines 6-9 and p. 30, lines 24-28, etc. The portions of the specification cited by applicants do not support the generic scope encompassed by, for example, independent claim 113. The specific vector, pEYC1003, which applicants assert possesses the elements recited in claim 113 in the order recited in said claim, only provides support for the pEYC1003 vector. The specification does not provide support for **any nucleic acid molecule** comprising the generic elements recited in claim 113. For example, the application as filed, does not provide support for a nucleic acid comprising in order, **any origin of replication** for any prokaryotic or eukaryotic genetic element, **any first positive selection marker**, **any first promoter** from any prokaryotic or eukaryotic source, **any first site specific recombination site**, **any coding sequence coding** for any protein, peptide, nonsense amino acid

sequence, etc., **any second positive selection marker** which can be the same or different from the first positive selection marker, **any second site specific recombination site** (same or different from the first site specific recombination site) and **any second promoter** which can be the same or different from the first promoter and wherein the first promoter is operably linked to the coding sequence and the second promoter is operably linked to the second positive selection marker. The application, as filed, does not support or contemplate the generic nucleic acid molecules as currently claimed. The species of nucleic acids disclosed in the instant application (pEZC1003) does not, in itself, provide support for the instant generic claims. This is a NEW MATTER rejection.

No Claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo, Ph.D., whose telephone number is (571) 272-0767. The examiner can normally be reached on Monday-Thursday from 8:00AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low, Ph.D., can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 19, 2008

/David Guzo/
Primary Examiner
Art Unit 1636